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PATENT

Attorney Docket No. A-70385-2/DJB/VBJ  
Attorney Matter No. 463678-00212  
Application No. 10/775,829

**REMARKS**

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendments, claims 1-20 are pending in the application, with claims 1, 15, and 17 being the independent claims. Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Applicants note that the present Amendment and Reply incorporates the remarks set forth in the Supplemental Amendment and Reply ("Supplemental Amendment") filed on August 17, 2006, which was not entered. As the Supplemental Amendment was filed in response to a personal interview with the Examiner, this Supplemental Amendment appears to address the Examiner's concerns raised in the Office Action of August 21, 2006.

Applicants thank the Examiner for the courtesy extended during the conversation of July 14, 2006. Applicant notes that the Examiner's Interview Summary accurately reflects the substance of the conversation. M.P.E.P. § 713.04. It is the understanding of the undersigned attorney that an agreement was reached with the Examiner and claims 1 and 15 will be allowable as amended to define the stem as separate from the closure cap subject to an updated search by the Examiner.

***Claim Objections***

The Examiner has raised an objection to claim 5 on the basis that there is insufficient antecedent for "said tab". Claim 5 has been amended to depend from claim 4 which recites "a tab". Applicants respectfully submit that the Examiner's objection is overcome by the accompanying amendment to claim 5.

***Double-patenting***

The Examiner rejects claims 1-20 based only on double-patenting over claims 1-20 of U.S. Patent No. 6,571,994.

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The Examiner states that "[t]he claims are read in light of the specifications and there is no teaching in the specification of the aperture being anywhere other than the 'central' portion of the spout top." Office Action, page 2. Applicants fail to understand the Examiner's rationale as the present claims do not call for a "central aperture". See, e.g., claim 1. As such, the present claims are not reciting the "same invention" as that which is claimed in the '994 patent.

With reference to M.P.E.P. § 804(II)(A), "[s]ame invention' means identical subject matter." See M.P.E.P. § 804(II)(A) (citations omitted). As set forth in the M.P.E.P., "[a] reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent." See *id.* In the present case, pending claim 1 could be literally infringed without infringing the claims of the '994 patent. In particular, a closure having a non-centrally located aperture could literally infringe the pending claim 1 but would not literally infringe the claims of the '994 patent. As such, the Examiner's rationale is in direct contradiction with the "reliable test" of double patenting set forth in the M.P.E.P. See *id.*

Applicants respectfully submit that, at best, any double patenting rejection over the '994 patent must be a nonstatutory obviousness-type double patenting rejection, which is readily overcome with a terminal disclaimer. Applicants respectfully submit that the previously submitted terminal disclaimer overcomes any such nonstatutory obviousness-type double-patenting rejection.

### ***Rejections under 35 U.S.C. § 102***

#### ***Claims 1-3, 6, 10, 11 and 13***

The Examiner has rejected claims 1-3, 6, 10, 11 and 13 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,477,743 to Gross et al. ("Gross"). Gross, taken individually or combined, fails to teach or suggest the three-component closure of the present invention including a cap, spout, and a *separate* stem, as is called for by independent claim 1. During the interview of July 14, 2006, the Examiner indicated that amended claim 1 is likely allowable over Gross for at least the following reason.

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As discussed during the interview, Gross does not disclose three-piece enclosure including a *separate* stem. Instead, Gross discloses a "closure system 20 [that] includes two basic components, [sic] (1) a body 30, [sic] and (2) a spout 40." See Gross, col. 5, lines 1-4. The Gross closure includes a spout 40 and closure body 30 having a base 50 and a reciprocable conduit 70 joined by a flexible wall 80. See Gross, col. 2, lines 49-54 and FIGs. 3-4. The conduit is thus *integrally* formed with the body. See Gross, FIGs. 3-4.

Moreover, Applicants respectfully submit that Gross fails to teach or suggest a *separate* stem that engages<sup>1</sup> a stem guide of the cap. Gross's conduit 70 cannot "engage" Gross's body 30 because Gross's conduit 70 is monolithically formed with Gross's body 30: conduit 70 and body 30 are merely portions of the same element. Gross's conduit 70 engages body 30 no more than the sides of a cube "engage" the top and bottom of a cube.

Applicant submits that claims 2, 3, 6, 10, 11 and 13, which depend from claim 1, are allowable over the cited art for at least the same reasons noted above.

***Claims 15-16, 18, and 20***

The Examiner has rejected claims 15-16, 18, and 20 under 35 U.S.C. § 102 as being anticipated by Gross. Gross, taken individually or combined, fails to teach or suggest the three-component enclosure of the present invention including a cap, spout, and a *separate* stem, as is called for by independent claim 15. During the interview of July 14, 2006, the Examiner indicated that amended claim 15 is likely allowable over Gross for at least the reasons mentioned above.

Moreover, and as noted above, Applicants respectfully submit that Gross fails to teach or suggest a *separate* stem that engages a stem guide of the cap. Gross's conduit 70 cannot "engage" Gross's body 30 because Gross's conduit 70 is monolithically formed with Gross's body 30: conduit 70 and body 30 are merely portions of the same element. Gross's conduit 70 engages body 30 no more than the sides of a cube "engage" the top and bottom of a cube.

<sup>1</sup> Engage: to interlock with : MESH; also : to cause (mechanical parts) to mesh <engage the clutch>. See [www.m-w.com](http://www.m-w.com), Merriam-Webster Online Dictionary, copyright © 2005 by Merriam-Webster, Incorporated.

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Applicant submits that claims 16, 18, and 20, which depend from claim 15, are allowable over the cited art for at least the same reasons noted above.

### *Claim 17*

The Examiner has rejected claim 17 under 35 U.S.C. § 102 as being anticipated by Gross. Gross, taken individually or combined, fails to teach or suggest the closure of the present invention including a stem that engages a stem guide of the cap, as is called for by independent claim 17.

As noted above, Applicants respectfully submit that Gross fails to teach or suggest a stem that engages<sup>2</sup> a stem guide of the cap. Gross's conduit 70 cannot "engage" Gross's body 30 because Gross's conduit 70 is monolithically formed with Gross's body 30: conduit 70 and body 30 are merely portions of the same element. Gross's conduit 70 engages body 30 no more than the sides of a cube "engage" the top and bottom of a cube.

As Gross neither discloses or suggests such a stem engaging a stem guide of the cap, it is clear that Gross cannot anticipate claim 17. Accordingly, Applicants respectfully submit that claim 17 is allowable over Gross and the other cited art of record.

### **CONCLUSION**

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

<sup>2</sup> Engage: to interlock with : MESH; also : to cause (mechanical parts) to mesh <engage the clutch>. See [www.m-w.com](http://www.m-w.com), Merriam-Webster Online Dictionary, copyright © 2005 by Merriam-Webster, Incorporated.

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The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extension of time or additional claims, and/or credit any overpayment to Deposit Account No. 50-2319 (Order No. 463678-00212; Docket No. A-70385-2/DJB/VEJ).

Prompt and favorable consideration of this Amendment and Response is respectfully requested

Respectfully submitted,

DORSEY & WHITNEY LLP

Date: November 14, 2006

By: 

Victor E. Johnson, Reg. No. 41,546

DORSEY & WHITNEY LLP  
Suite 1000  
555 California Street  
San Francisco, California 94104-1513  
Telephone: (415) 781-1989 Facsimile: (415) 398-3249

4H41-0606-336.A1